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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,615	08/28/2003	Hitoshi Suzuki	16987	8298
23389 7590 05/12/2010 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER COBANOGILU, DILEK B				
ART UNIT 3626		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/650,615

Applicant(s)

SUZUKI ET AL.

Examiner

DILEK B. COBANOGU

Art Unit

3626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27 and 31-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27 and 31-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/GS-08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 2/3/2010 (2 IDS's)

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment received on 2/2/2010. Claims 27, 31-39 remain pending in this application.

Specification

New Matter

2. The amendment filed 2/2/2010 is objected under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:
3. The newly added recitation of "and when the server system receives, from the terminal, the medicine name data indicating the name of the medicine in the broken injection bottle, **the server system reissues a medical order regarding the medicine in the medicine in the broken injection bottle**" within claim 31. In particular, Applicant does not point to, nor was the Examiner able to find, any support for this limitation within the specification as originally filed. The specification recites: "[0272] When there is a break detected in an injection bottle for any reason in a hospital room during the mixing process, data has to be input about the break. This is hereinafter referred to as a break inputting job. [0327] A break in a bottle can be a break before mixing medicines (any of the medicine to be mixed leaking out of its container or the container itself having a break) and a break after mixing medicines (a bottle carefully dropped after mixing medicines and the medicines spilling out, etc.). [0328] Normally, the mixing process with

a instillation bottle is performed by a nurse, and there is a nurse execution system exclusive for a mixing process so that no error occurs. If a break is detected relating to a single medicine before entering the process of the nurse execution system exclusive for the mixing process, a break inputting job is performed before a mixing process. If a break is detected relating to a bottle after completing the mixing process in the process of the nurse execution system exclusive for the mixing process, a break inputting job is performed after the mixing process. [0331] In the case of a break in a bottle before or after mixing, break data is input on a bottle label check screen G26. The break data is input in steps S109 through S111 and S106 shown in FIG. 26". Therefore the present specification and the drawings do not recite "reissue" or "reorder" for the medicine in the broken injection bottle, the present invention only recites "recording damaged medicine". As such, Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

4. Applicant is required to cancel the new matter in the reply to this office action.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 31 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention and for the reasons set forth in the objection to the specification above. Claim 31 recites limitation that is a new matter, as discussed above.

7. New matter objection and 35 U.S.C. 112, first paragraph rejection of claims 32, 33, 34, 37, 38 and 39 have been withdrawn since the Applicant amended the claims and removed the new matter from the claims.

Claim Objection

8. Objection of claim 27 has been withdrawn since the Applicant amended the claim to correct the insufficient antecedent basis.

9. Claims 33 and 34 are objected to since the claims still recite "the arithmetic processing unit", which has been removed from the other parts of these claims, and also removed from language of other claims, and this feature introduce new matter into the disclosure of the invention.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claim 27 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language "data indicating a name of a medicine in a broken injection bottle" in claim 27 is static and brings no structural distinction, this information is not changing the processing of the system; the language is considered nonfunctional descriptive material related to information stored in a

terminal (or computer). This data does not change any process in the claims. It is unclear if "the data indicating a name of a medicine in a broken injection bottle" is for inventory purposes or recording/reporting an error in the medication container.

12. The descriptive material does not make a system part (terminal, server or hospital management system) to make a process. See MPEP 2106.

13. Arguments related to 35 U.S.C. 101 rejection is addressed below in the section titled "Response to Arguments".

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

15. Claims 27, 32-39 are rejected under 35 U.S.C. 102(a) as being unpatentable by Sasaki (JP, 09-245093, A, Portable Nursing Job Supporting System).

A. Claim 27 has been amended now to recite an information system for use in a hospital, comprising:

- i. a terminal inputting and outputting data relating to medical activities (Sasaki; par. 0001, 0010);
- ii. a server system communicating the data with said terminal (Sasaki; par. 0016); and

iii. a hospital information management system recording information communicated by said server system in the hospital, and centrally managing the information (Sasaki; par. 0010, 0020),

wherein said terminal comprises:

a scheduled medical job data input/output unit inputting and outputting data of medical activities normally scheduled and transmitted as instructions from said server system according to a medical order (Sasaki; par. 0001, 0020); and

an unscheduled medical job data input/output unit inputting and outputting data of medical activities unscheduled and not transmitted as instructions from said server system wherein the data of medical activities unscheduled is medicine name data indicating a name of a medicine in a broken injection bottle (Sasaki; par. 0020, 0027, 0028, 0038).

Sasaki does not specifically mention a broken injection bottle. However, these differences are only found in the nonfunctional descriptive material and do not alter the functions of inputting, receiving, searching, matching, transmitting and outputting data. The descriptive materials do not alter how Sasaki functions. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2nd 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

B. Claim 32 has been amended now to recite an information system for use in a hospital, comprising:

- i. a terminal including a central processing unit, and inputting and outputting data via the central processing unit executing an application program (Sasaki; par. 0001, 0010, 0017); and
- ii. a server system communicating the data with said terminal (Sasaki; par. 0010, 0016, 0017);

wherein: when a request to terminate a connection between said terminal and said server system is received from said terminal, said server system transmits, to said terminal, data for update of an application program being executed by the central processing unit which said terminal includes (Sasaki; par. 0017, 0024, 0029, 0035); and

said terminal updates the application program being executed by the central processing unit which the terminal includes, based on the data transmitted from said server system and used for the update (Sasaki; par. 0017, 0024, 0029, 0035).

C. Claim 33 has been amended now to recite an information system for use in a hospital, comprising:

- i. a terminal including a central processing unit, and inputting and outputting data via the **arithmetic** processing unit executing an application program (Sasaki; par. 0001, 0010, 0017); and

- ii. a server system communicating the data with said terminal (Sasaki; par. 0010);

wherein: said terminal updates the application program being executed by the central processing unit which said terminal includes, based on the data transmitted from said server system and used for update of the application program (Sasaki; par. 0017, 0020, 0027);

when the request for a connection between said terminal and said server system is transmitted from said terminal, said server system transmits information about availability of the updated application program to said terminal (Sasaki; par. 0020); and

when the information transmitted from said server system indicates that the updated application program is available, said terminal allows the central processing unit to execute the updated application program, and inputs and outputs the data (Sasaki; par. 0017, 0020).

- D. Claim 34 has been amended now to recite an information system for use in a hospital, comprising:

- i. a terminal including a central processing unit, and inputting and outputting data via the **arithmetic** processing unit executing an application program (Sasaki; par. 0001, 0010, 0017); and
- ii. a server system communicating the data with said terminal (Sasaki; par. 0020, 0024);

wherein: said server system contains data for use in updating an application program being executed by the central processing unit which said terminal includes, and can set in said server system a starting date from which the terminal can execute the updated application program via the central processing unit (Sasaki; par. 0017, 0020, 0024);

said terminal is configured to update the application program based on the data transmitted from said server system for use in the update (Sasaki; par. 0024, 0029);

when said server system is connected to said terminal before the set starting date and the data for use in the update is not transmitted from said server system to said terminal, said server system transmits the data to the terminal to store the data in (Sasaki; par. 0024, 0029);

when said server system is connected to said terminal after the set starting date and the data for use in the update is transmitted from said server system to said terminal, said server system allows said terminal to update the application program based on the data (Sasaki; par. 0024, 0029); and

when said server system is connected to said terminal after the set starting date and the data for use in the update is not transmitted from said server system to said terminal, said server system transmit the data to said terminal and allows said terminal to store the data and update the application program based on the data (Sasaki; par. 0024, 0029).

E. As per claim 35, Sasaki discloses the system according to claim 32, wherein data input and output by said terminal relates to medical activities (Sasaki; par. 0001, 0020).

F. As per claim 36, Sasaki discloses the system according to claim 32, wherein said terminal ignores other input to said terminal when said terminal receives data from said server system for use in updating the program (Sasaki; par. 0020, 0024, 0035).

G. Claim 37 has been amended now to recite a server system which is a component of an information system for use in a hospital, comprising:

i. a data communications device communicating data with a terminal which is a component of the information system, includes a central processing unit, and inputs and outputs data via the central processing unit executing an application program (Sasaki; par. 0001, 0017, 0020); and

ii. an update data transmission unit transmitting, to the terminal, data for use in updating an application program being executed by the central processing unit which the terminal includes, when a request to terminate a connection is received from the terminal (Sasaki; par. 0017, 0024, 0029, 0034).

H. Claim 38 has been amended now to recite a server system which is a component of an information system for use in a hospital, comprising:

- i. a data communications device communicating data with a terminal which is a component of the information system, includes a central processing unit, and inputs and outputs data via the central processing unit executing an application program (Sasaki; par. 0001, 0017, 0020);
 - ii. an update data transmission unit transmitting, to the terminal, data for use in updating an application program being executed by the central processing unit which the terminal includes (Sasaki; par. 0017, 0024, 0029, 0035); and
 - iii. a program availability information transmission unit transmitting, to the terminal, information indicating whether or not and application program after update can be executed via the central processing unit which the terminal includes, when a request for a connection is received from the terminal (Sasaki; par. 0017, 0024, 0029, 0035).
- I. Claim 39 has been amended now to recite a terminal which is a component of an information system for use in a hospital, comprising:
- i. A central processing unit (Sasaki; par. 0001, 0020);
 - ii. an input/output unit inputting and outputting data via the central processing unit executing an application program (Sasaki; par. 0001, 0017, 0020);
 - iii. a data communications device communicating the data with a server system which is a component of the information system (Sasaki; par. 0001, 0020); and

iv. an application program update unit updating the application program based on data transmitted from the server system for use in updating the application program (Sasaki; par. 0024, 0029),
wherein said input/output unit inputs and outputs data by allowing the central processing unit to execute executing an updated application program when information transmitted from the server system at a request transmitted to the server system to connect to the server system indicates permission of execution availability of the updated application program via the central processing unit which the terminal includes (Sasaki; par. 0017, 0024, 0029, 0035).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki (JP, 09-245093, A, Portable Nursing Job Supporting System), White et al. (hereinafter White) (U.S. Patent No. 6,790,198 B1) and further in view of Examiner's Official Notice.

A. Claim 31 has been amended to recite the system according to claim 27, wherein said unscheduled medical job data input/output unit inputs the name of the medicine in the broken injection bottle by reading an identification code attached to the injection bottle by an identification code reader provided for said

terminal, or by a user of said terminal manually inputting the code; and when the server receives, from the terminal, the medicine name data indicating the name of the medicine in the broken injection bottle, the server system reissues a medical order regarding the medicine in the broken injection bottle.

Sasaki fails to expressly teach "reading an identification code attached to the injection bottle by an identification code reader provided for said terminal, or by a user of said terminal manually inputting the code".

However, this feature is well known in the art, as evidenced by White.

In particular, White discloses this feature (White; col. 9, lines 35-58).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by White with the motivation of comparing patient information to the label on the physical container (White; col. 9, lines 46-47).

Sasaki and White fail to specifically teach the newly added limitation, and when the server receives, from the terminal, the medicine name data indicating the name of the medicine in the broken injection bottle, the server system reissues a medical order regarding the medicine in the broken injection bottle, per se, however, Examiner takes Official Notice that it was well known in the medical arts to reorder or reissue a medicine when the medicine container (or injection bottle) is damaged or broken. The motivation would have been to replace the medication and provide the medication to the patient.

Response to Arguments

18. Applicant's arguments filed 8/27/2009 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear.

A. In response to Applicant's argument about 35 U.S.C. 101 rejection of claim 27, Examiner respectfully submits the parts from MPEP Chapter 2106 related to nonfunctional descriptive material. Examiner's interpretation for "the data of medical activities unscheduled is medicine name data indicating a name of a medicine in a broken injection bottle" is a compilations of data, and therefore this part of the limitation is rejected under 35 U.S.C. 101 for being nonfunctional descriptive material.

2106.01 [R-6] Computer-Related Nonstatutory Subject Matter

II. NONFUNCTIONAL DESCRIPTIVE MATERIAL

Nonfunctional descriptive material that does not constitute a statutory process, machine, manufacture, or composition of matter and should be rejected under 35 U.S.C. 101. Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture, or composition of matter.

Also, Examiner respectfully submits that the limitation is "wherein the data of medical activities unscheduled is medicine name data indicating a name of a medicine in a broken injection bottle" and **wherein** clause merely expresses the intended results; therefore, it does not limit the claim and is not given patentable weight (see MPEP 2111.04).

B. In response to Applicant's argument about Sasaki does not teach "data indicating a name of a medicine in a broken injection bottle", Examiner respectfully submits that this feature represents a nonfunctional descriptive material related to information stored in the terminal as explained above in 101 and claim rejection of claim 27, and also above in the section A.

C. In response to Applicant's argument about Sasaki does not teach newly added term "arithmetic processing unit"; Examiner respectfully submits that this term has been removed from the claims, since it constitutes a new matter. Applicant argues about the canceled and removed subject matter. Applicant continues and argues that Sasaki does not teach "updating the application program executed by the "central processing unit", and Examiner respectfully submits that Sasaki teaches this limitation and CPU in paragraph 0017.

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
20. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DILEK B. COBANOGLU whose telephone number is (571)272-8295. The examiner can normally be reached on 8-4:30.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on 571-272-6787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. B. C./
Examiner, Art Unit 3626
4/30/2010

/Robert Morgan/
Primary Examiner, Art Unit 3626